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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/498,949    02/04/00    RODAWAY    S    0646/1F153-U

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New York NY 10022

HM1270920

EXAMINER
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FRONDA, C

ART UNIT	PAPER NUMBER
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1652

DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
**09/498,949**

Applicant(s)  
**Rodaway et al.**

Examiner  
**Christian L. Fronda**

Art Unit  
**1652**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) 1-8 and 10-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicants' election with traverse of Group II, claim 9, in Paper No. 7 dated 9/5/01 is acknowledged. The traversal is on the ground(s) that the product of Group II and process of making the product of Group I are not distinct because the claimed product is produced by the claimed method since the inhibitor of tryptophan synthase is specifically tailored and identified by the method of Group I.

This is not found persuasive because as stated in the previous Office Action, the inventions of Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as by generating a structural model of a plant tryptophan synthase by homology modeling to a known tryptophan synthase structure and designing a compound that fits into the structure of said generated structural model.

The requirement is still deemed proper and is therefore made FINAL. Claims 1-8 and 10-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claim 9 is under consideration in this Office Action.

### ***Claim Objections***

3. Claim 9 is objected to because of the following informalities: Claim 9 depends from a non-elected invention. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and

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distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 which depends from claim 1 recites the limitation "herbicidal inhibitor". There is insufficient antecedent basis for this limitation in the claim since "herbicidal inhibitor" is not recited in claim 1.

For examination purposes it is assumed that claim 9 is directed toward an inhibitor of tryptophan synthase.

***Claim Rejections - 35 U.S.C. § 112, 1st Paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim is directed to all possible tryptophan synthase inhibitors identified using an *in vitro* assay comprising contacting tryptophan synthase with a test compound and determining whether tryptophan synthase activity is inhibited. The specification, however, does not provide a written description of the claimed inhibitor other than being identified by said *in vitro* assay. There is no disclosure of any particular structure to function/activity relationship in the disclosed indole-3-propanol phosphate inhibitor for which predictability of structure of any other tryptophan synthase inhibitor can be determined. The specification also fails to describe additional representative species of these tryptophan synthase inhibitors by any identifying structural characteristics or properties other than being identified using said *in vitro* assay. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

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***Claim Rejections - 35 U.S.C. § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Wolf et al.

Claim 9 is a product by process claim; and no patentable weight is given to the process by which the claimed tryptophan synthase inhibitor is identified or made. For examination purposes, the claim is assumed to be directed toward any inhibitor of tryptophan synthase.

Wolf et al. teach several tryptophan synthase inhibitors: indolepropionic acid, indolebutyric acid, indoleacetic acid, indolepyruvic acid, and indoleacrylic acid (see Table 3, p. 274). The assay conditions to measure the inhibition of reaction is described on page 270, ***Tryptophan Synthase Assays.***


Thus, the reference teachings anticipate the claimed tryptophan synthase inhibitor.

***Conclusion***

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF

  
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